

REMARKS

This responds to the Office Action mailed on April 7, 2009.

Claims 1, 6, 10, 11, 21, 26, 30-36, 38-43, and 50-54 are amended, claims 8, 15-20, 37, and 44-49 are canceled, and no claims are added; as a result, claims 1-7, 9-14, 21-36, 38-43, and 50-54 remain pending in this application.

Claim Objections

Claims 6, 8, 19, 21, 26, 35, 37 and 48 were objected to due to informalities. Applicant has canceled claims 8, 19, 37, and 48 amended claims 6, 21, 26, and 35 to correct the noted informalities. Entry of these amendments is respectfully requested.

§ 112 Rejection of the Claims

Claims 10 and 39 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. Applicant has amended claims 10 and 39 to correct the noted antecedent basis issues. Withdrawal of the 35 U.S.C. § 112, second paragraph rejections is respectfully requested.

§ 101 Rejection of the Claims

Claims 30-54 were rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. Applicant has canceled claims 44-49 and amended each of claims 30-43 and 50-54 to clarify that the claims are directed toward machine-readable storage mediums as supported in the application as originally filed on page 6, lines 10-15. Although carrier waves, infrared signals, and digital signals are described in this portion of the application, the claims are not explicitly directed to tangible storage mediums. Thus, Applicant respectfully requests withdrawal of the 35 U.S.C. § 101 rejections of claims 30-43 and 50-54.

§ 103 Rejection of the Claims

Claims 1, 2, 5, 15-20, 30, 31, 34, 40 and 44-49 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kepler et al. (U.S. 7,103,589; hereinafter “Kepler”) in view of Parham et al. (U.S. 6,879,564; hereinafter “Parham”).

Claims 3, 6, 9, 10, 12, 13, 26, 29, 32, 35, 38, 39, 41 and 42 were also rejected under 35 U.S.C. § 103(a) as being unpatentable over Kepler in view of Parham and further in view of Bondarenko et al. (U.S. 2004/0083479; hereinafter “Bondarenko”).

Claims 4, 14, 33 and 43 were also rejected under 35 U.S.C. § 103(a) as being unpatentable over Kepler in view of Parham and further in view of Jiao (U.S. 7,376,827; hereinafter “Jiao”).

Claims 7, 8, 21-24, 27, 28, 36, 37 and 50-53 were also rejected under 35 U.S.C. § 103(a) as being unpatentable over Kepler in view of Parham and Bondarenko, and further in view of Jiao.

Claims 25 and 54 were also rejected under 35 U.S.C. § 103(a) as being unpatentable over Kepler et al. in view of Parham et al., Bondarenko and Jiao, and further in view of Robb et al. (U.S. 2003/0120502; hereinafter “Robb”) and Chu et al. (U.S. 6,006,331; hereinafter “Chu”).

Bondarenko, Jiao, Robb, Chu

As noted above, claims 8, 15-20, 37, and 44-49 are canceled.

Applicant has amended each of independent claims 1, 6, 11, 21, 26, 30, 35, 40, and 50 to clarify that an optimization technique identifier, as included in each of the independent claims, is one of a plurality of possible optimization technique identifiers that are each associated with a respective optimization technique. The amendments further clarify that there are a plurality of possible optimization techniques. Examples of the various techniques are described in the application as originally filed at page 11, line 27 – page 13, line 6.

Applicant respectfully submits that these amendments clarify the patentable nature of the independent claims 1, 6, 11, 21, 26, 30, 35, 40, and 50. For example, Kepler admittedly fails to provide a teaching of an optimization technique identifier that identifies an optimization technique to be performed as similarly set forth in each of the independent claims. Parham is asserted to provide such teachings. However, the amendments to the claims clarify that there are a plurality of possible optimization techniques. Conversely, Parham discloses only a single process that could possibly be classified as an optimization technique, that being the “shortest path.” Parham simply fails to teach or suggest a plurality of optimization techniques.

Applicant also submits that Parham further fails to provide a teaching or suggestion of an optimization technique identifier. Parham, having only a single possible optimization technique, need not identify the optimization technique with an identifier. Further, if the asserted combination were to be made, the single optimization process of Parham teaches away from including an optimization technique identifier because when there is only one option, that option is the only option that can be pursued. A single option need not be identified if it is the only option.

Thus, Applicant respectfully submits that the combination of Kepler and Parham fails to render the independent claims obvious as the asserted combination fails to teach or suggest all the elements of the claims and because Parham teaches away from the asserted combination.

Bondarenko, Jiao, Robb, Chu are provided to show additional elements included in some of the independent claims, but these references fail to cure the deficiencies of Kepler and Parham.

Thus, Applicant respectfully submits that independent claims 1, 6, 11, 21, 26, 30, 35, 40, and 50 are patentable over the asserted combination of references. Claims 2-5, 7, 9-10, 12-14, 22-25, 27-29, 31-34, 36-39, 41-43, and 51-54 depend from one of the patentable independent claims and are also patentable for at least the same reasons.

Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejections and allowance of claims 1-7, 9-14, 21-43, and 51-54.

AMENDMENT AND RESPONSE UNDER 37 C.F.R. § 1.111

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CONCLUSION

Applicant respectfully submits that claims 1-7, 9-14, 21-43, and 51-54 are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's representative at (612) 373-6938 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

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